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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/863,037	05/23/1997	BERNARD A. WEINSTEIN	01985-P0032A	4253
7590	04/06/2005		EXAMINER	
ST ONGE STEWARD JOHNSTON & REENS 986 BEDFORD STREET STAMFORD, CT 069055619			DALENCOURT, YVES	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	08/863,037	WEINSTEIN ET AL.	
	<b>Examiner</b> Yves Dalencourt	<b>Art Unit</b> 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 18 October 2004.  
2a)  This action is **FINAL**.                  2b)  This action is non-final.  
3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-4 and 11-17 is/are pending in the application.  
    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-4 and 11-17 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## **Application Papers**

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All   b)  Some \* c)  None of:

  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

This office action is responsive to amendment filed on 10/18/2004.

### ***Response to Amendment***

The examiner has acknowledged the amended claims 1, 11, and 15.

### ***Response to Arguments***

Applicant's arguments filed on 10/18/2004 have been fully considered but they are not persuasive.

Applicants argue that Potter fails to disclose or taught or suggested three separate telecommunication links, a first via which the indication of the market condition to be monitored is transmitted, a second via which the confirmation of receipt is transmitted, and a third via which the notification that the market condition has been found to exist is transmitted (page 10, first paragraph). However, the examiner contends that Potter does suggest that all messages sent from the client PC to the applications servers, as well the reverse, are channeled through the message router (see fig. 1). The message router also directs messages by and between the applications servers (col. 5, line 60 through col. 6, line 44).

Applicants also argue that it would be impossible to use the system of Potter et al in a wireless environment at the time the present application was filed in 1997. However, such argument is moot since a first, a second, or a third **wireless** communication link per se was not claimed. Potter et al has shown in fig. 1 that several

connections have made between "FX TRADE GUI" and "FX ORDER GUI" and "server environment" and so on through the message router 44.

Therefore, the rejection is repeated based on the above arguments.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 - 2, 4, 11 - 12, and 14 - 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Potter et al (US 5787402; hereinafter Potter).

Regarding claims 1, 4, 11, and 15 - 16, Potter et al teaches a method and system for performing automated financial transactions involving foreign currencies (col. 3, lines 48 – 50) which comprises a user computer for specifying a market condition to be monitored and a corresponding client ID via a first telecommunication link (10, figure 1; col. 3, lines 15 – 22; col. 5, lines 50 – 60); an electronic source of updated market data ( col. 14, lines 14 - 17); a host computer system including a database for receiving and storing a plurality of the market conditions specified for monitoring and the corresponding client IDs (102, figure 2; col. 13, lines 44 - 50); confirmation data generated and transmitted by said host computer system via a second

telecommunication link upon receipt of the specified market condition and corresponding client ID by said database, said confirmation data indicating that the specified market condition has been received by said host computer and will be monitored (col. 14, lines 21 - 27); monitoring program executable on said host computer system for comparing each of the specified market conditions stored on said host computer system and said source of updated market data to determine if a specified market condition is found in said source of updated market data, said monitoring program generating a signal if a specified market condition is found to exist, the signal indicative of the found specified market condition and the corresponding client ID stored on said host computer system (col. 14, lines 9 - 14); and a transmitter responsive to said signal for transmitting notification of the specified market condition via a third communication link (col. 4, lines 14 - 21).

Regarding claims 2, 12, and 17, Potter further teaches a program executable on said user computer for providing share price momentum as market condition to be monitored (col. 3; lines 26 - 29).

Regarding claim 14, Potter further teaches a computer aided real-time decision support system and method wherein said user computer includes a communication server (44, figure 1; col. 4, lines 54 - 59).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

In the alternative, claims 1 - 2, 4, 11 - 12, and 14 - 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter et al (US 5,787,402; hereinafter Potter) in view of James W. Wiseman (US 5,168,446; hereinafter Wiseman).

Regarding claims 1, 4, 11, and 15 - 16, Potter et al teaches a method and system for performing automated financial transactions involving foreign currencies (col. 3, lines 48 – 50) which comprises a user computer for specifying a market condition to be

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monitored and a corresponding client ID (10, figure 1; col. 3, lines 15 – 22; col. 5, lines 50 – 60); an electronic source of updated market data ( col. 14, lines 14 - 17); a host computer system including a database for receiving and storing a plurality of the market conditions specified for monitoring and the corresponding client IDs (102, figure 2; col. 13, lines 44 - 50); confirmation data indicating that the specified market condition has been received by said host computer and will be monitored (col. 14, lines 21 - 27); monitoring program executable on said host computer system for comparing each of the specified market conditions stored on said host computer system and said source of updated market data to determine if a specified market condition is found in said source of updated market data, said monitoring program generating a signal if a specified market condition is found to exist, the signal indicative of the found specified market condition and the corresponding client ID stored on said host computer system (col. 14, lines 9 - 14); and a transmitter responsive to said signal for transmitting notification of the specified market condition (col. 4, lines 14 - 21).

Potter teaches all the limitations in claim 1, but fails to specifically teach that said confirmation data is generated and transmitted by said host computer system upon receipt of the specified market condition and corresponding client ID by said database.

However, Wiseman teaches, in the same field of endeavor, a system for conducting and processing spot commodity transaction, which teaches confirming pending trades, when the trades fall outside certain limitations before transmitting a proposal (col. 4, lines 6 – 9; claimed confirmation data generated and transmitted by

said host computer system upon receipt of the specified market condition and corresponding client ID by said database).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Potter's device by using a confirmation data generated and transmitted by said host computer system upon receipt of the specified market condition and corresponding client ID by said database in as evidenced by Wiseman for the purpose of avoiding financial catastrophe in a similar system by confirming data.

Regarding claims 2, 12, and 17, Potter and Wiseman teach all the limitations, and Potter further teaches a program executable on said user computer for providing share price momentum as market condition to be monitored (col. 3; lines 26 - 29). Regarding claim 14, Potter and Wiseman teach all the limitations, and Potter further teaches a computer aided real-time decision support system and method wherein said user computer includes a communication server (44, figure 1; col. 4, lines 54 - 59).

Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Potter and Wiseman as applied to claims 1 and 11, above, and further in view of Vanden Heuvel et al US 5281962; hereinafter Vanden Heuvel).

Regarding claims 3 and 13, Potter and Wiseman teach all the limitations but fail to specifically teach a system wherein said user computer specifies the market condition to be monitored in electronic mail format.

However, Vanden Huevel et al teaches, in an art related field of providing information to users, a reliable information service message delivery system wherein

said user computer specifies the market condition to be monitored in electronic mail format (col. 3, lines 24 - 38) for the purpose of reliably delivering information service messages to communication receiver in a communication system.

Thus, it would have been obvious to one of ordinary skill in the art to have used a system wherein said user computer specifies the market condition to be monitored in electronic mail format in Potter and Wiseman 's system as taught by Vanden Huevel for ease of use and also to reliably deliver information service messages to communication receiver in a communication system.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt

  
April 1, 2005



SALEH NAJJAR  
PRIMARY EXAMINER